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APPLICATION NO.	F	ILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,348		10/29/2001	Christopher Oldfield	0435.064	6458
23405	7590	04/04/2003			
HESLIN R	OTHENI	BERG FARLEY &	EXAMINER		
	5 COLUMBIA CIRCLE ALBANY, NY 12203			KUHAR, ANTHONY J	
				ART UNIT	PAPER NUMBER
				1754	
	•	•		DATE MAILED: 04/04/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application Ma	AS				
		Application No.	Applicant(s)				
_	Office Action Summary	10/037,348	OLDFIELD, CHRISTOPHER				
	cine chesion Cammary	Examiner	Art Unit				
	The MAILING DATE of this communication on	Anthony J Kuhar	1754				
Period fo	The MAILING DATE of this communication ap r Reply	pears on the cover sheet with the	e correspondence address				
- Exter after afte	ORTENED STATUTORY PERIOD FOR REPL MAILING DATE OF THIS COMMUNICATION. Islands of time may be available under the provisions of 37 CFR 1. SIX (6) MONTHS from the mailing date of this communication. period for reply specified above is less than thirty (30) days, a repperiod for reply is specified above, the maximum statutory period to reply within the set or extended period for reply will, by statute eply received by the Office later than three months after the mailing dipatent term adjustment. See 37 CFR 1.704(b).	136(a). In no event, however, may a reply be ly within the statutory minimum of thirty (30) d will apply and will expire SIX (6) MONTHS fro	timely filed lays will be considered timely. on the mailing date of this communication.				
1)[🛛	Responsive to communication(s) filed on 2/15	9/03 in paper no. 9 .					
2a)□		nis action is non-final.					
3) Disposition							
4)🖂	Claim(s) <u>1-8 and 11-13</u> is/are pending in the a	application.					
	a) Of the above claim(s) 8 is/are withdrawn fro	om consideration.					
	Claim(s) is/are allowed.						
6)⊠	Claim(s) <u>1-7 and 11-13</u> is/are rejected.						
	Claim(s) is/are objected to.						
1	Claim(s) are subject to restriction and/o	r election requirement					
Application	on Papers						
9)□ T	he specification is objected to by the Examine	r.					
10)□ T	he drawing(s) filed on is/are: a)□ accep	oted or b) objected to by the Exa	aminer.				
	Applicant may not request that any objection to the	e drawing(s) be held in abeyance.	See 37 CFR 1.85(a).				
11)∐ T	he proposed drawing correction filed on	is: a) approved b) disappr	oved by the Examiner.				
	If approved, corrected drawings are required in rep	oly to this Office action.					
12) <u> </u>	he oath or declaration is objected to by the Exa	aminer.					
Priority ur	nder 35 U.S.C. §§ 119 and 120						
13)⊠ <i>A</i>	Acknowledgment is made of a claim for foreign	priority under 35 U.S.C. § 119(a)-(d) or (f).				
] All b) ☐ Some * c) ⊠ None of:	- '	1				
1	.⊠ Certified copies of the priority documents	s have been received.					
2	2. Certified copies of the priority documents		tion No.				
	B. Copies of the certified copies of the prior application from the International Burse the attached detailed Office action for a list of	ity documents have been receiv eau (PCT Rule 17.2(a))	ed in this National Stage				
	knowledgment is made of a claim for domestic						
_ a)	☐ The translation of the foreign language processnowledgment is made of a claim for domestic	visional application has been red	ceived.				
Attachment(s		, , , , , , , , , , , , , , , , , , , ,					
2) Notice 3) Informa	of References Cited (PTO-892) of Draftsperson's Patent Drawing Review (PTO-948) tion Disclosure Statement(s) (PTO-1449) Paper No(s) 4.	5) Notice of Informal	y (PTO-413) Paper No(s) Patent Application (PTO-152)				
J.S. Patent and Trad PTO-326 (Rev.	04.04)	ion Summary	Part of Paper No. 10				

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DETAILED ACTION

Election/Restrictions

Claims 8 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 9.

Claim Objections

Claims 1, 2, 4-7, and 11-13 are objected to because of the following informalities:

Claim 1 is objected to because it is not clear how the chelating reagent is employed and it is not clear what defines pH control. It is also written awkwardly.

Claim 2 is objected to because it is written awkwardly.

In claim 4, the phrase "(the extraction step)" in parenthesis is superfluous.

In claim 4, the phrase "(the separation step)" in parenthesis is superfluous.

In claim 4, the phrase "(the recovery step)" in parenthesis is superfluous.

Claims 5, 7, 11, and 13 is objected to because the phrase "e.g. a quaternary ammonium group" is not clear whether the quaternary ammonium group is actually required.

Claims 6 and 12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claimed "sulphonic and carboxylic groups" encompass more chelating agents than those recited in the parent claims.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 4-7, and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, "predetermined pH" is indefinite, see Joseph E. Seagram and Sons v. Marzall, 84 USPQ 180.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "different pH", and

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the claim also recites "(usually a lower pH)" which is the narrower statement of the range/limitation.

The term "wide range" in claim 2 is a relative term which renders the claim indefinite. The term "relatively narrow" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification does not disclose what "wide range" of pH entails.

The term "relatively narrow" in claim 2 is a relative term which renders the claim indefinite. The term "relatively narrow" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification does not disclose what "relatively narrow" entails.

The term "essentially" in claim 4 is a relative term which renders the claim indefinite.

The term "essentially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification does not disclose what "essentially pure form" entails.

Claims 5, 7, 11, and 13 are indefinite because they recite an improper Markush grouping "selected from". The "and" before "sodium salts" should be deleted. A comma followed by "and" should be placed before "polydentate ligands".

Regarding claims 5, 7, 11, and 13, the phrase "and the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by

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"or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claims 6 and 12 recited an improper Markush grouping "selected from".

Claims 6 and 12 recites the limitation "the chelating groups". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by FR 2510140.

FR 2510140 teaches on page 2 solubilizing a mineral with a complexant, separating a liquid phase from any residue, titrating the resulting liquid phase to precipitate the mineral from the solution, and recycling the solution containing the complexant upon regeneration. Column 3, line 25 teaches the mineral can be calcium sulfate. Page 4, lines 24-25 teach amino-carboxylic and quaternary ammonium compounds are useful as the complexants.

Claims 1-7 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Paul '196.

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Paul '196 teaches contacting scale with an aqueous solvent comprising a

polyaminopolycarboxylic acid or salt, acidifying the solvent with an acid chelating agent to

precipitate an alkaline earth sulfate, separating the precipitate from the solvent, and increasing

the pH for regenerating the solvent containing the chelating agent for reuse to dissolve scale.

EDTA is can be used as the chelating agent (see column 2, lines 25). Column 2, line 67 teaches

that calcium sulfate forming the scale can be removed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J Kuhar whose telephone number is 703-305-7095. The

examiner can normally be reached on 8:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stan Silverman can be reached on 703-308-3837. The fax phone numbers for the

organization where this application or proceeding is assigned are 703-872-9310 for regular

communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-308-0661.

ΑK

April 2, 2003

STEVEN BOS

IMARY EXAMINI CROUP 1100